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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,232	12/02/2003	Daniel E. Morse	1279-281N2/09900075	5734
167	7590	06/04/2004	EXAMINER	
FULBRIGHT AND JAWORSKI L L P			MOORE, MARGARET G	
PATENT DOCKETING 29TH FLOOR			ART UNIT	
865 SOUTH FIGUEROA STREET			PAPER NUMBER	
LOS ANGELES, CA 900172576			1712	

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

App. cat. on No.

10/727,232

App. can(s)

MORSE ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 to 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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1. The instant application is a continuation of 09/856,599 and the pending claims are the same as those originally examined. As such this rejection is the same as that found in the first office action in the parent application.

2. A telephone call was made to applicants attorney on 6/1/04 to determine if a preliminary amendment was filed in this application. The application transmittal form indicates that one was filed but the Examiner could not find one. Mr. Berliner confirmed that no preliminary amendment was filed in this application.

3. Applicants are requested to update the status of the parent application in the specification.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 to 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Meder or Levene .

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Meder teach a method for the polymerization of a silicon alkoxide, one meeting the limitation of claim 2, and form a polysilsesquioxane. The method combines the alkoxide with a catalyst and polymerizes. The dibutyltindilaurate and stannous oleate therein are catalysts having a pH of about neutral. This anticipates the instant claims.

Levene teach a method for the polymerization of a silicon alkoxide, one meeting the limitation of claim 2, forming a polysilsesquioxane. The method combines the alkoxide with a catalyst and polymerizes. The ferric alkoxide and ferric chelate therein are catalysts having a pH of about neutral. This anticipates the instant claims.

7. Claims 5 to 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimizu et al., as interpreted by applicants' specification.

Shimizu et al. teach silicateins. Applicants admit this on page 7 of their specification. Page 8 of the specification admits that the silicateins therein have the amino acid sequence required by claims 7 and 8. This anticipates the instant claims.

The Examiner notes that claim 5 is essentially drawn to a protein or polypeptide. Defining it as a catalyst or stating that it assembles, hydrolyzes and condenses does not lend novelty to an otherwise known compound. The Examiner does not believe that applicants' intent is to claim such a broad and known group of compounds.

8. Claims 10 and 11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Askay et al.

Askay et al. teach the formation of poly silicon alkoxide tubules. Note that the instant claims are drawn to a product by process. The prior art need not teach the process of claim 1. The instant claims are drawn to a silicified structure having a shape, specifically a filament, sphere, elongated globule or column. The teachings of Askay et al. form a silicified structure having a shape, specifically a tubule structure. Such tubules meet the claimed "filaments", "elongated globules" and "columns". Thus, while the process of preparing the shaped silicified structure is different than that of claim 1, it is the product per se that is claimed in claim 10 and 11, and the shaped silicified product in Askay et al. appear to be inherently the same as that claimed.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
6/1/04